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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,756	03/16/2005	Nicola Caldoro	1-16767	8354
7590 Marshall & Melhorn Four SeaGate 8th Floor Toledo, OH 43604			EXAMINER DHAROD, KHUSHAL R	
			ART UNIT 4111	PAPER NUMBER
			MAIL DATE 05/22/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/508,756

Applicant(s)

CALDORO ET AL.

Examiner

KHUSHAL DHAROD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/22/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6,7 and 8 is/are rejected.
- 7) ☒ Claim(s) 2,9,10,11, and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1-13-06; 3/16/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-10, 11 and 13 are drawn to a method of making a glazing.

Group II, claim 12 is drawn to an apparatus for molding an appendage onto a glazing.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common technical feature in claims 1 and 12 of adding appendage to the existing profile, while the glass profile remains outside the mold cavity. This technical feature is not special since this technical feature is not novel as has been demonstrated by Cornils et al (JP 09123213) fig 5.

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Species 1: Polymer material is a fluid (claim 3).

Species 2: Polymer material is a preformed piece of solid material (claim 4).

4. The inventions listed Species 1 and 2 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common technical feature in claims 3 and 4 of adding polymer in fluid state and polymer being already in a preformed (solid) state constitute materially different physical states.

5. Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

6. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. During a telephone conversation with Attorney Donald A Schurr on 05-05-2008 a provisional election was made with traverse to prosecute the invention of method of

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making a glazing, claims 1-3, 5-11, and 13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4 and 12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 3, and 5-8 are rejected under 35 U.S.C. 102(b) as being unpatentable over Cornils et al (JP 09123213).

Cornils et al JP '213 teaches a process for molding an appendage on a glazing. As clearly illustrated in the figure 5, a mold is advanced into a sealing contact with a glazing on peripheral portion of a glass pane (¶ 17). Moreover, Cornils JP '213 further teaches injecting a molding material through an opening 23 into a cavity of the mold to form an appendage (12) on a lip (10) of the glazing (4), wherein the glass pane remains outside the mold cavity being in contact with the lip (numbered paragraphs 0001, 0007-0009, 0013-0014; fig 5).

As per claim 3, since the molding material is injection molded, then it must inherently be in a fluid condition.

As per claim 5 see figure 1 and claim 1 in JP '213 for the discussion on forming a glazing onto a glass pane by extrusion. JP '213 also teaches that "up mold can be removed from a window pane with a core without spoiling a profile" (¶ 0009).

As per claim 6, see figures 4-5. Moreover, as noted earlier, the appendage is molded onto lip of the glazing.

As per claim 7 and 8, as illustrated in figure 4-5 and discussed in numbered paragraph 0009, the appendage in JP '213 forms an extension of the lip and provides lip with a vertex adjacent corner.

Allowable Subject Matter

11. Claims 2, 9, 10, 11, and 13 are objected to as being dependent upon a rejected base claim 1, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject:

Claim 2 is allowable because there is no reasonable suggestion in the art to modify the process of JP'213 such that mold is open when the polymer is introduced into it and closed after the introduction.

Claim 9 is allowable, because there is no reasonable suggestion in the art to modify the process of JP '213 such that a second mold half is maintained at lower temperature than the first mold.

Claims 10 and 13 are allowable for being dependent on allowable claim 9.

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Claim 11 is allowable, because there is no reasonable suggestion in the art to modify the molding operation of JP '213 to have a mold which does not contact with a glass pane.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHUSHAL DHAROD whose telephone number is (571)270-5520. The examiner can normally be reached on Monday-Thursday: 7:30AM-5:00PM(EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam C. Yao can be reached on (571) 272-1224. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. D./

Examiner, Art Unit 4111

/Sam Chuan C. Yao/

Supervisory Patent Examiner, Art Unit 4111